

REMARKS

This Application has been carefully reviewed in light of the Non-Final Office Action mailed March 26, 2010. At the time of the Office Action, Claims 25-35 were pending in this Application and were rejected. Claims 25 and 35 have been amended to further define various features of Applicant's invention. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §102

Claims 25, 26, 29, 31, 32, 34 and 35 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,250,887 issued to Dardik et al. ("Dardik"). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With regard to claims 25 and 35, Dardik does not set forth one of the pump or cannula having a handle to leverage insertion of the cannula into an implant site, as is now recited by amended claims 25 and 35. The presently-claimed system is used for vertebroplasty procedures, which requires access to an implant site that typically comprises hard tissue such as bone. In order to access this manner of implant site, considerable leverage must be applied by the surgeon in order to traverse and access the implant site. The device described by Dardik is used for accessing an artery, and does not describe a handle associated with the pump or cannula, but rather describes a flexible tube as the interfacing structure between the tissue access site for the needle and the pump. Because Dardik does not set forth every element as recited in amended claims 25 and 35, Dardik cannot anticipate claims 25 and 35 as amended. For at least these

reasons, Applicant submits that claims 25 and 35 are in condition for allowance, and respectfully request withdrawal of the rejection.

Claims 26, 29, 31, 32, and 34 depend either directly or indirectly from claim 25. Applicant hereby repeats and incorporates the above comments with regard to amended claim 25. For at least these reasons, Applicant submits that claims 26, 29, 31, 32, and 34 are in condition for allowance, and respectfully requests withdrawal of the rejection.

Rejections under 35 U.S.C. §103

Claims 27, 28 and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dardik.

Claim 33 was rejected under 35 U.S.C. §103(a) as being unpatentable over Dardik in view of U.S. Patent No. 5,496,284 issued to Waldenburg ("Waldenburg"). Applicant respectfully traverses and submits the cited art, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

When determining whether a claim is obvious, the Examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well settled that obviousness requires at least a suggestion of all the features in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, "*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Claims 27, 28, and 30 depend directly or indirectly from claim 25. Applicant hereby repeats and incorporates the comments made above with regard to amended claim 25. For at least these reasons, Applicant submits that claims 27, 28 and 30 are in condition for allowance and requests withdrawal of the rejection.

Claims 33 depends directly from claim 25. Applicant hereby repeats and incorporates the comments made above with regard to amended claim 25. Specifically, neither Dardik nor

Waldenburg at least suggest one of the pump or cannula having a handle to leverage insertion of the cannula into an implant site. For at least these reasons, Applicant submits that claim 33 is in condition for allowance and requests withdrawal of the rejection.

Information Disclosure Statement

Applicant encloses an Information Disclosure Statement and PTO Form 1449, for the Examiner's review and consideration.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$180 for the IDS and any additional fees necessary and/or credit any overpayments to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.358.5925.

Respectfully submitted
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Enclosure: 1) Information Disclosure Statement and PTO Form 1449.